

### **REMARKS/ARGUMENTS**

These remarks are made in response to the Office Action of June 27, 2006 (Office Action). As this response is timely filed within the 3-month shortened statutory period, no fee is believed due. However, the Office is expressly authorized to charge any deficiencies or credit any overpayments to Deposit Account No. 50-0951.

Claims 3, 13, and 16 were objected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to point out and distinctly claim the subject matter which Applicant regards as the invention. Claims 1-23 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,006,197 to D'Eon *et al.*, (hereafter D'Eon), in view of U.S. Patent Application Publication No. 2002/0123957 to Notarius *et al.* (hereinafter Notarius). Claims 1-23 were further rejected under 35 U.S.C. § 103(a) as being unpatentable over Oracle iMarketing (12/1999 article), in view Notarius.

#### **Objections under 35 U.S.C. § 112**

Claims 3, 13, and 16 were objected in the Office Action under 35 USC §112, second paragraph, it being asserted that the claims include terminology making the claims "vague." Applicants respectively submit that the term "format convert" is not vague and call attention to the Specification at page 10, lines 16-24 (emphasis added):

The e-marketing message controller 120 further can be configured to vary the bandwidth required for transmission of e-marketing content. In particular, the e-marketing message controller 120 can format convert electronic content representing pictures, video, audio, and other multi-media content, and either increase or decrease the resolution and/or quality of the respective electronic documents. Accordingly, the bandwidth required to transmit the electronic content can be increased or decreased. Thus, for example, under high network traffic conditions, an audio file can be sample rate converted as well as converted from one file format to another to suit the available bandwidth of the system 100.

Applicants therefore submit the term "format convert" refers to increasing or decreasing the resolution or quality of electronic content, including pictures, video, audio, and other multimedia content. Therefore Applicants respectfully request withdrawal of the objection to this term.

**Applicants' Invention Predates Notarius**

Moreover, Applicants' invention predates the December 29, 2000, effective date of Notarius. Applicants conceived of their invention at least as early as October 5, 2000, and actively pursued its reduction to practice from a date prior to the effective date of Notarius. In support of their assertion, Applicants submit the Declarations attached hereto. The Declarations establish conception and continuing diligence from a time prior to the effective date of Notarius to the filing of the Application.

Along with the Declarations, Applicants also submit herewith a copy of Confidential Invention Disclosure No. BOC9-2001-0041, entitled *Method for dynamically modified electronic marketing based on network activity* (hereinafter Disclosure). The Disclosure was submitted on May 2, 2001, by Applicants to an intellectual property (IP) professional employed by the assignee of Applicants' invention, International Business Machines Corporation (hereinafter IBM). The Disclosure was insubstantially modified by an IBM professional on May 3, 2001. As affirmed in the Declarations, the modifications did not in any way change the actual invention disclosure. As explained below, IBM internal procedures preclude any modification to the description of the invention subsequent to submission to an IBM professional.

The Disclosure explicitly describes Applicants' invention. The written description provided in the Disclosure is clear evidence of Applicants' conception of the claimed subject matter at least as early as October 5, 2000.

The Disclosure is an IBM confidential disclosure form. It is a standardized document that, according to established IBM procedures, is used by IBM inventors to document the conception of an invention. Strictly-followed internal procedures established by IBM govern the use of all such confidential disclosure forms. One aspect of IBM's established procedures governing the use of such confidential disclosure forms is that no substantive modifications can be made to a confidential disclosure after it has been submitted to an IBM Attorney/IP Professional.

The written description, drawings, and each of the claims of the Application were prepared based upon the Applicants' attached Disclosure. Moreover, according to IBM's established procedures governing the use of such disclosures, the inventors reviewed the Application prior to its submission to the U.S. Patent and Trademark Office in order to ensure that the claims and written description contained therein were fully supported by the Disclosure.

Applicants exercised due diligence from prior to the effective dates of Notarius to the date that the Application was filed. As expressly affirmed in the Declarations, Applicants from at least October 5, 2000, through the filing of the Application, worked diligently toward a constructive reduction to practice of the invention, first with IBM's own in-house IP professionals, and then with outside counsel retained by IBM to prepare and file the Application.

Outside counsel prepared the Application consistent with long-established professional practices, according to which cases are prepared on a first-in, first-out basis unless a particular application is associated with a bar date; those applications associated with dates are granted priority within the work queue. Outside counsel followed this professionally-accepted practice in preparing the Application in this case.

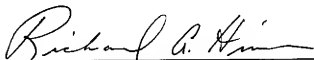
**CONCLUSION**

Applicants believe that this application is now in full condition for allowance, which action is respectfully requested. Applicants request that the Examiner call the undersigned if clarification is needed on any matter within this Amendment, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,

AKERMAN SENTERFITT

Date: September 27, 2006



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Prepared for and/or by an IBM Attorney - IBM Confidential

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Required fields are marked with the asterisk (\*) and must be filled in to complete the form.

**\*Title of disclosure (in English)**

### Method for dynamically modified electronic marketing based on network activity

## Summary

[illegible]

### Inventors with a Blue Pages entry

**Inventors:** Colin Meiser/Dallas/IBM, Cindy O'Shea/Dallas/IBM

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> denotes primary contact				

### Inventors without a Blue Pages entry

Select Functional Area

IDT Team:	Attorney/Patent Professional: Richard Tomlin/Boca Raton/IBM
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**\*Main Idea**

1. Describe your invention, stating the problem solved (if appropriate), and indicating the advantages of using the invention.

This is a method for metering outbound electronic marketing (e-marketing) campaign information based upon the capacity of the electronic network to handle both outbound and inbound transmissions generated by the e-marketing campaign. The metering will also measure how successful the e-marketing campaign is in terms of size of audience, responses to the campaign and the potential financial outcome of the e-marketing effort. It will then adjust the content and electronic flow of the e-marketing information accordingly. This will provide advantages over traditional electronic marketing in that; (1) the relative value of the e-marketing content to the targeted audience will be adjusted sooner and more frequently, in order to optimize the results of the e-marketing campaign and (2) the amount of network traffic generated by the e-marketing campaign can be adjusted to limit the possibility of network outages affecting public relations as related to public access to the network.

2. How does the invention solve the problem or achieve an advantage, (a description of "the invention", including figures inline as appropriate)?

This invention allows for the analysis of network capacity and the analysis of marketing effectiveness to occur simultaneously and in a manner that allows for immediate, real time response to a change in the status of either network capacity or marketing requirements. By coordinating the output of network load balancing and capacity analysis software with software that monitors and analyzes e-marketing campaign execution, the type, quantity and targeted audience of an e-marketing effort can be dynamically altered to match the operational qualities of a computer network. This coordination will be performed by software that meters the flow of e-marketing data and will interact with software responsible for e-marketing message delivery, and with software responsible for dynamic network analysis, to alter the flow and content of e-marketing messages. These messages may be flowing to traditional electronic messaging services, such as e-mail or web page banners, or it may flow through new, non-traditional messaging services such as wireless messaging, location proximity messaging or even currently undiscovered methods of electronic message delivery.

The e-marketing meter will control the flow of messages from the e-marketing campaign delivery software and regulate the flow based upon available network capacity, as determined by the dynamic network analysis software. The e-marketing meter will also determine the number of response messages being received as a result of the e-marketing campaign. This response rate will be factored into calculations determining the number of marketing campaign messages to be sent. Thus the network capacity, the amount of outbound message network bandwidth required and the amount of inbound message network bandwidth required will become factors in the calculations performed by the e-marketing meter to determine the rate of flow for outbound e-marketing messages.

The metering of the e-marketing message flows is intended to prevent an overloading of network capacity that would result in unfavorable public relations with both the targeted campaign audience and the general public. Additionally, it should help prevent loss of network capacity for other, unrelated business functions that would result in unfavorable public relations with current customers. The metering will also allow for real time calculations on the response rate and indirectly from the response rate, the success rate of a campaign, as the campaign is in progress. This analysis while in progress will allow for adjustments to the e-marketing campaign materials before the campaign is completed. It will also allow for dynamic changes to the flow of e-marketing messages. Message flows currently targeted for a private audience, such as e-mail messages, could be re-routed to public devices, such as web banner pages or vice versa, depending upon the response rate being detected. This has the added benefit of making e-marketing campaigns more quickly adaptable to the target audience and at a lower cost in terms of the amount of advertising material shipped before alterations are made.



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3. If the same advantage or problem has been identified by others (inside/outside IBM), how have those others solved it and does your solution differ and why is it better?

Currently this problem is being solved as two separate issues within the computer industry. An

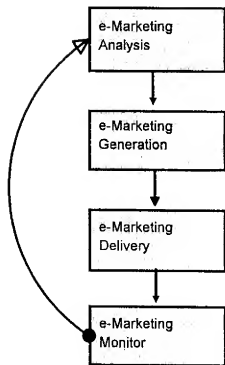
e-marketing campaign is developed and a target audience is identified before a quantitative analysis is done on the amount of network traffic the campaign will theoretically generate. At this point network analysis is performed to determine the current peak capacity of the network minus any non-marketing related traffic that already exists on the network. If it appears the e-marketing campaign will in some way overload the network, the campaign's target audience is then artificially limited or a strategy is developed to execute the e-marketing campaign in stages that allow the total outbound e-marketing and the inbound consumer response to fit within the computer network capacity. With the current methodology, much of the analysis is theoretical and based on historical data and statistical probability, rather than on the reality of the current network operational characteristics and the current e-marketing campaign. This has led in the past to many network performance or network capacity related public relations blunders, when either the network capacity estimates or the e-marketing campaign success calculations did not match the reality of the e-marketing campaign execution.

4. If the invention is implemented in a product or prototype, include technical details, purpose, disclosure details to others and the date of that implementation.  
There is currently not a prototype.

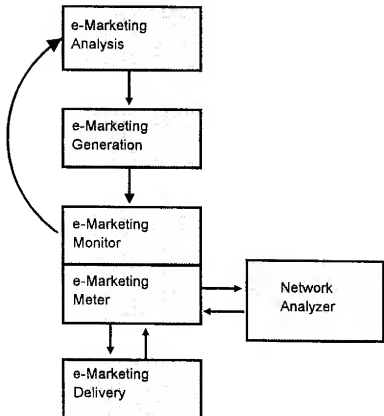
**\*Critical Questions (Questions 1-9 must be answered in English)**

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## Existing Method

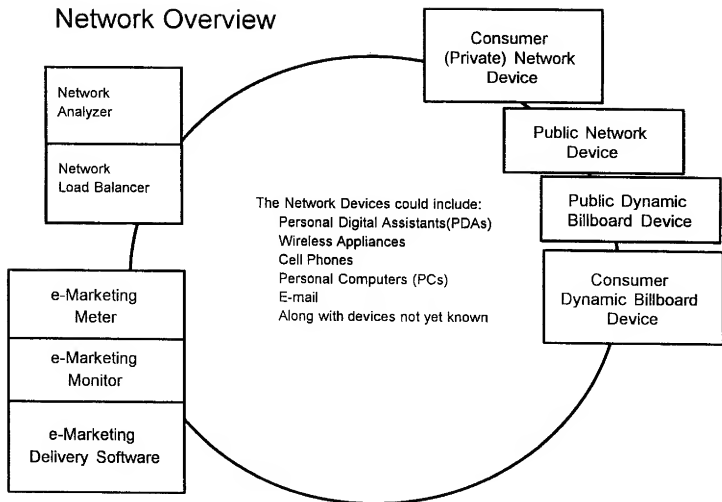


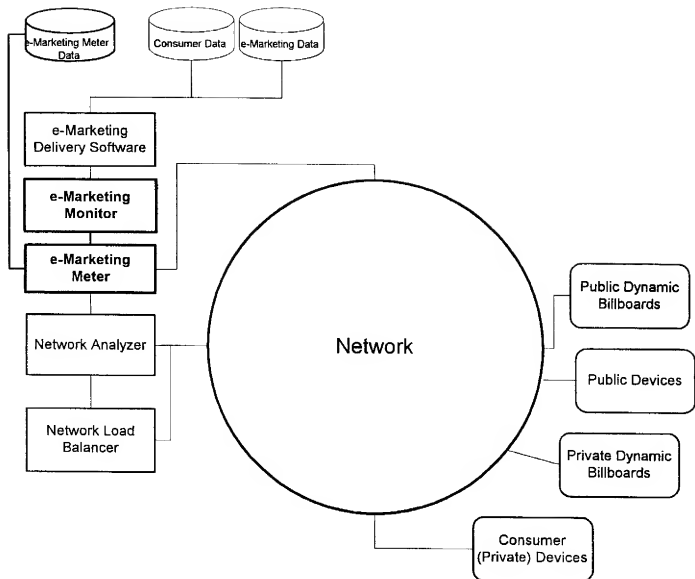
## Dynamic Method





## Network Overview





Steps Involved in  
Dynamically Modified Electronic Marketing Based On  
Network Activity:

1. e-Marketing Analysis
2. Network Analysis
3. e-Marketing Campaign Generation
4. e-Marketing Campaign Delivery  
(Partial, Metered Delivery)
5. Network Analysis Combined With  
e-Marketing Effectiveness Analysis
6. e-Marketing Campaign Modification
7. e-Marketing Campaign Delivery  
(Partial, Metered Delivery Based on  
Network Activity and Measured e-Marketing  
Effectiveness)

Iterate Steps 5 through 7 until the e-Marketing  
Campaign is complete.